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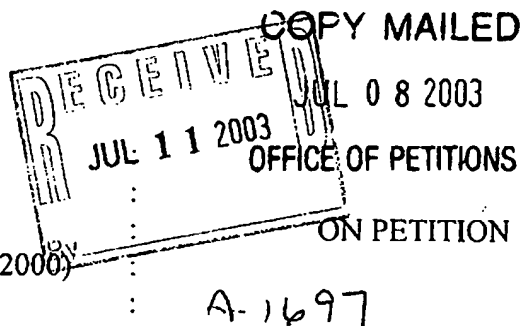
STOUT, UXA, BUYAN & MULLINS LLP  
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IRVINE CA 92618

In re Application of  
Rapoport

Application No. 08/482,402

Filed: June 7, 1995 (Last CPA filed June 13, 2000)

Attorney Docket No. 102105.151CI



This is a decision on the petition under 37 CFR 1.183, filed June 13, 2003, requesting waiver of the rules and revival of the instant application.<sup>1</sup>

The petition is **DISMISSED**.

Facts:

A Notice of Allowance and Issue Fee Due was mailed to applicant on May 1, 2002. The Notice set a three month statutory period for payment of the Issue Fee. Therefore, the issue fee was due on or before August 1, 2002.

Petitioner submitted payment of the Issue Fee on July 18, 2002 (Certificate of Mailing Date) which was received on July 24, 2002. The Issue Fee Transmittal Form directed the Office to charge the Issue Fee to Deposit Account No. 13-5135.

On July 25, 2002, the Office attempted to charge the issue fee to the deposit account. However, the Office was unable to charge the issue fee of \$1,280 due to insufficient funds in the deposit account. On July 25, 2002, the deposit account contained less than \$700.

37 CFR 1.25(a) states,

For the convenience of attorneys, and the general public in paying any fees due, in ordering services offered by the Office, copies of records, etc., deposit accounts may be established. . . . An amount sufficient to cover all fees, services, copies, etc., requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted.

The charge to the deposit account, which had insufficient funds, was not accepted.

On July 31, 2002, \$5000 was deposited into the deposit account.

Petitioner did not take steps to inform the Office that the funds in the account had been replenished and the Office did not attempt to recharge the deposit account.

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<sup>1</sup> The petition under 37 CFR 1.181 will be forwarded to the Technology Center for consideration of the merits of the petition.

The application became abandoned on August 2, 2002, due to petitioner's failure to timely pay the issue fee.

On September 16, 2002, the Office mailed a Notice of Abandonment, which stated the application had become abandoned because the issue fee had not been received by the Office.

Petitioner assumed the issue fee transmittal form had not been received by the Office. On October 1, 2002, petitioner filed a petition to withdraw the holding of abandonment alleging the issue fee transmittal form had been timely filed.

With the petition, petitioner submitted a page entitled "Transmittal of Payment of Issue Fee." The page instructed the Office to charge \$1,280 for the issue fee to petitioner's deposit account. Upon receipt of the petition and attachments, the Office charged \$1,280 to petitioner's deposit account and forwarded the file to the Technology Center for consideration of the merits of the petition. The individual who charged the \$1,280 did not consider the merits of the petition and did not determine whether the application was abandoned or not abandoned. Instead, the individual simply followed the financial instructions made by petitioner and then forwarded the petition to the Technology Center for consideration of the merits of the petition.

The individual who charged the fee gave the fee a "mailroom date" in computer records of October 1, 2002.<sup>2</sup> Therefore, the individual determined the date of payment of the issue fee to be October 1, 2002, two months after expiration of the application.<sup>3</sup> The fee was clearly charged in response to the deposit account authorization mailed on October 1, 2002, and not the deposit account authorization mailed on July 18, 2002. Even if the individual had the right to determine the issue fee was paid within three months of the notice of allowance, the individual did not in so far as the individual assigned a mail date of October 1, 2002, to the issue fee. Unless the issue fee is paid within three months of a notice of allowance, the application goes statutorily abandoned and can only be revived under 37 CFR 1.137.

The file and petition were physically received in the Technology Center on October 9, 2002.

On December 2, 2002, the Office mailed a decision dismissing the petition. The decision informed petitioner that the Office had received the issue fee transmittal form but the Office was unable to charge the issue fee due to insufficient funds in the deposit account. The decision suggested petitioner file a petition under 37 CFR 1.137(b).<sup>4</sup>

On December 27, 2002, petitioner filed a request for reconsideration of the December 2, 2002 decision and in the alternative, filed a petition under 37 CFR 1.137(a) and 37 CFR 1.137(b). The

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<sup>2</sup> The accounting date for the payment is October 3, 2002.

<sup>3</sup> 35 U.S.C. 151 states:

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter. Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

<sup>4</sup> A grantable petition under 37 CFR 1.137(b) must be accompanied by the required reply (the issue fee), the petition fee (which was \$1,280 on December 2, 2002), and a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Since the issue fee had been charged to petitioner's deposit account on October 3, 2002, a petition under 37 CFR 1.137(b) would have only required payment of the issue fee and the statement.

petition noted the deposit of additional funds on July 31, 2002, and stated,

[T]he application was improperly abandoned because sufficient funds were present in the deposit account prior to the deadline for payment of the issue fee, and the PTO reasonably should have attempted to re-charge the issue fee on the deadline, rather than merely hold the application abandoned.

An additional petition was filed January 14, 2003. The petition requested the "paper filed on December 27 be superseded by the present filing." Petitioner argued the application could not be abandoned because the issue fee was charged to petitioner's deposit account on October 3, 2002.

A decision was mailed on May 7, 2003, dismissing the petition for reconsideration under 37 CFR 1.181 and dismissing the petition under 37 CFR 1.137(a). The merits of the alternative petition under 37 CFR 1.137(b) were not considered. The decision failed to take into consideration the January 14, 2003 petition because the petition had not been matched with the file as of May 7, 2003.

The instant petition requests consideration of the merits of the January 14, 2003 petition and provides further arguments alleging the application is not abandoned. In addition, the instant petition requests waiver of the rules under 37 CFR 1.183.

Analysis:

The petition under 37 CFR 1.181 to withdraw the holding of abandonment:

The record indicates that the May 7, 2003 decision did not take into consideration the merits of the petition filed on January 14, 2003. For example, the Office did not consider petitioner's arguments that the holding of abandonment was withdrawn automatically when the Office charged the issue fee to petitioner's deposit account. Therefore, the file will be forwarded to the Technology Center to consider the petition filed on January 14, 2003, and the instant petition, to the extent the petitions request withdrawal of the holding of abandonment.

The petition under 37 CFR 1.183:

A standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation.<sup>5</sup> Since Congress has provided a specific scheme for the revival of abandoned applications (*i.e.*, the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (*e.g.*, 37 CFR 1.182 or 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 133, and 151.<sup>6</sup>

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<sup>5</sup> See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode").

<sup>6</sup> See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989) (the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

That is, it would be an inappropriate exercise of 37 CFR 1.182 or 1.183 to, in essence, revive this abandoned application. Rather, the appropriate remedy is revival of this abandoned application by way of acceptance of the belated issue fee under 35 USC 151 and 37 CFR 1.137.

In addition to the above, it is brought to petitioner's attention that "justice" does not require an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. In this case, petition may seek revival under 37 CFR 1.137.

Petitioner may wish to strongly consider filing a petition under 37 CFR 1.137(b).

**Petitioner may wish to note that delay in the filing of a grantable petition, such as a petition under 37 CFR 1.137(b), may result in a smaller patent term for the patent which issues from the instant application.** In general, the term of a patent is 20 years from the effective filing date. Therefore, a delay in filing a grantable petition will lengthen the time a patent takes to issue and thereby may shorten the patent term which will be obtained by the applicant.

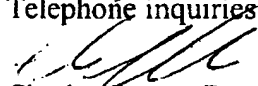
A short form which may be completed in order to seek revival under 37 CFR 1.137(b) is attached. Petitioner may wish to complete the form and submit it, along with \$1,300, in order to revive the application. Upon revival, the application will be forwarded to the Office of Publications for issuance into a patent.

Petitioner may wish to file a supplemental Issue Fee Transmittal Form. The instant form has the name of the state of Delaware misspelled.

The petition fee of \$130 paid on October 1, 2003, will be applied to the fee for the instant petition.

The file is now being forwarded to Technology Center 1600 for the consideration of the petition filed on January 14, 2003, and the instant petition, to the extent the petitions request withdrawal of the holding of abandonment.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at ~~(703) 306-5683~~.

  
Charles Steven Brantley  
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Office of Petitions

new 571-272-  
# 3203

Attached: PTO/SB/64